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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,209	12/31/2003	Paul A. Puniello	20002.0384	6677
23517	7590	03/21/2005		
SWIDLER BERLIN LLP 3000 K STREET, NW BOX IP WASHINGTON, DC 20007			EXAMINER HUNTER, ALVIN A	
			ART UNIT 3711	PAPER NUMBER

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/748,209	PUNIELLO ET AL
	Examiner	Art Unit
	Alvin A. Hunter	3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 31 December 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/20/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (USPN 5833553).

Regarding claims 1 and 16-18, Sullivan et al. discloses a golf ball product comprising a core and a cover surrounding the core wherein the cover includes an inner layer of a first material and an outer layer of a second material. Sullivan et al. notes that the inner and outer layer may optionally contain additives such as dyes, pigment, etc. Furthermore, the material in which is used for the cover layer is ionomer which is inherently transparent. One ordinarily skilled in the art would have drawn herefrom that one can add any type of additive to any layer of the cover so long as the properties of the layers are deteriorated; therefore, making the addition of the additives obvious.

Regarding claims 2-5, Sullivan et al. discloses the inner layer and the outer layer having thicknesses wherein the combined thickness of the layers is at least 3.8mm, wherein each layer is at least 0.25mm (0.010 inch). One having ordinary skill in the art would have drawn from Sullivan et al. that the thickness of inner layer can be greater or less than the thickness of the outer layer; and therefore, would have been obvious to do so long as the combined thickness of the two layers are at least 3.8mm. If in doubt,

regarding claim 3, Example 4 shows a golf ball having an inner cover being greater in thickness than the outer cover wherein the outer layer has a thickness of 0.070 inch. Applicant does not teach why approximately 0.065 is critical to attain the invention; therefore, it is submitted that Sullivan et al. would have resulted in the same properties of that of the applicant's invention, *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Regarding claim 6, Sullivan et al. discloses the second material being harder than the first material (See Figure 2).

Regarding claims 7-11, Sullivan et al. discloses the first and second materials being greater than 60 Shore D wherein the difference between the two layers being at most 5 units.

Regarding claims 12 and 13, Sullivan et al. discloses that more than two cover layer may be placed over the core. Furthermore, one of the cover layers would be the structural equivalent to that of an intermediate layer.

Regarding claim 14, Sullivan et al. notes that a finish coating may be placed over the fabricated golf ball wherein the golf ball includes a core and cover layers (See Column 18, lines 30 through 34).

2. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (USPN 5833553) in view of Sullivan (USPN 6315681).

Regarding claims 19 and 20, Sullivan et al. does not discloses a colored additive concentrated at particular location on the golf ball. Sullivan et al. discloses a golf ball having visible weighting in which the weight is visible through the outer cover (See

Abstract). It is apparent that the weighting elements have some form of color being that it is visible through the cover of the golf ball. Furthermore, Sullivan shows in Figures 10, 11, 12, and 13 appear to show the colored weighting element around an equator or around poles of the golf ball. One having ordinary skill in the art would have found it obvious to incorporate the weighting elements of Sullivan, into Sullivan et al. in order to increase the moment of inertia and to provide the golf ball with an attractive appearance.

***Conclusion***

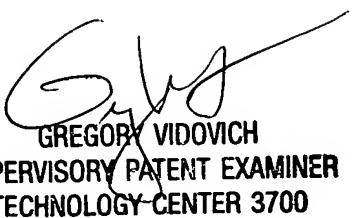
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH  
Alvin A. Hunter, Jr.



GREGORY VIDOVICH  
SUPERVISORY PATENT EXAMINER  
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